

- 3 -

Remarks

A terminal disclaimer is enclosed to overcome the obviousness-type double patenting rejection.

Claims 27-31 and 33-43 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,263,233. This rejection is respectfully traversed on the grounds that the 35 U.S.C. §102(e) rejection is not proper where the rejection is based on a patent not "by another" (see MPEP 2136.04). The inventive entity of U.S. Patent No. 6,263,233 is identical to the inventive entity of the present application, since both have the same Applicants. Thus, U.S. Patent No. 6,263,233 is not "by another" inventive entity as required for a 35 U.S.C. §102(e) rejection.

Claims 27-31 and 34-36 were rejected under 35 U.S.C. §102(b) by Harris (U.S. Patent No. 5,120,953). Claims 27 and 34 have been amended to describe a window having a surface capable of being pressed into a contact relationship with the surface of the tissue sample. The Examiner at item 6 of the Office Action dated July 2, 2002 states that in Harris "negative pressure...pulls/sucks the soft tissue towards the cup, provides a [negative pressure] contact between the window and the tissue to be examined". Harris at column 6, lines 55-63, states "[w]hen a particular spot is identified for closer examination, the outer barrel is moved to the extended position as illustrated in FIG. 8 to bring the focusing lens system 82 into the optic path and the tissue to be examined is sucked into the end of spigot 81 by application of suction to one of the tubes 83 so that it is properly positioned and held steady...for examination". Clearly, no window is pressed into contact with tissue in Harris, as Harris does not press any window onto tissue, but instead relies on the use of suction in a cup to suck up tissue as the Examiner pointed out.

It should further be evident that such use of negative pressure does not suggest that any contact is occurring between its focusing lens system and the tissue surface, as FIGS. 6 and 8 of Harris actually shows a spigot providing a cup in which a space appears to be present between the tissue surface and the lens system.

The absence of contact between the Harris focusing lens system and the tissue surface is also supported by its use of suction to suck tissue to a proper position and held steady for examination. Harris does not appear to describe any means to select the depth of imaging into the tissue, but for its use of suction to position tissue in its cup for examination (see column 6, lines 60-63). Although scanning is provided, the transducer (71) within the endoscope head of

- 4 -

FIG. 8 appears limited to scanning the beam transverse (i.e., along X and Y directions) to the optical axis, which is not capable of effecting depth of imaging by focusing lens system (82). Therefore, the only means to position the tissue sample relative to the "point observational field" and therefore "properly position" the tissue for examination is by adjusting the suction. Thus, it cannot be suggested that Harris has a contact relationship between any window and tissue surface, as contended by the Examiner, where such a contact relationship would negate the ability in Harris to adjust image depth by its focusing lens system via suction to position tissue with respect to such focusing lens system. Moreover, the lack of a contacting relationship is further supported by Harris' use of a fluid to "cleanse the area to be examined..." (column 6, lines 63-64). If the tissue were in contact with the end of the focusing lens (82), the observational field would be sealed and fluid would not flow to cleanse the observational field.

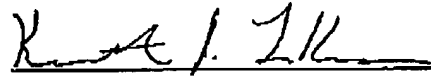
Although Applicants do not believe that Harris in FIG. 8 shows a window in pressure contact with the tissue sample, Applicants are amending Claims 27 and 34 to clarify the claimed invention rather than to overcome the rejection. For the above reasons, Harris does not anticipate Claims 27 and 34, and withdrawal of the 35 U.S.C. §102(b) rejection of Claims 27 and 34, and respective dependent Claims 28-31 and 35-36, is requested.

Claim 36 has been amended to depend on Claim 35 to correct an error in antecedence.

Claims 44-48 have been added to the application, and are believed patentable over Harris. A combined Amendment Transmittal Letter and Petition for a three-month extension of time is enclosed with authorization to charge the required \$511.00 fee to deposit account 50-1101.

Respectfully submitted,

Dated: December 30, 2002


Kenneth J. LuKacher
Registration No. 38,539

South Winton Court
3136 Winton Road South, Suite 204
Rochester, New York 14623
Telephone: (585) 424-2670
Facsimile: (585) 424-6196

Enclosed: Appendix with Marked-up Version of Amended Claims;
Terminal Disclaimer;
Combined Amendment Transmittal Letter and Petition for Extension of Time (in duplicate); and
Certificate of Mailing by Express Mail, Express Mail No. EV 104334775 US.

- 5 -

APPENDIX

Marked-up version of amended Claims 27, 34, and 36

27. (twice amended) A microscopic imaging apparatus for imaging tissue samples for pathological applications through an objective lens, said apparatus comprising:

an objective lens;

a window having a surface capable of being pressed into [in] a [pressure] contact relationship with the surface of said tissue sample in which said window is in optical communication with said objective lens; and

a housing capable of being handheld having at least said objective lens and said window.

34. (twice amended) A system for imaging and diagnosing a tissue sample for pathological applications comprising:

an objective lens;

a window having a surface capable of being pressed into [in] a [pressure] contact relationship with the surface of said tissue sample;

a housing capable of being handheld having at least said objective lens and said window;

an illumination beam which is focused by said objective lens through said window to said tissue sample, in which said objective lens receives returned light from said tissue sample representing a tissue section; and

means for displaying said tissue section to diagnose abnormalities in said tissue sample.

36. (amended) The system according to Claim 35 [34] wherein said tumor represents one of carcinomas and melanomas.